

## **II. REMARKS**

### **Preliminary Remarks**

Claims 23 to 25, 27, 29, 31 to 66, and 68 to 78 are pending of which claims 23 to 25, 27, 29, 31, 34 to 38, 44, 47, 51, 53, 58, to 66, 68 to 73, 75, and 76 are independent.

The applicants would like to thank the examiner for the indication of allowable subject matter in claims 25, 31 to 33, 35 to 58, 63 to 66, and 68 to 73.

In particular, claims 23, 61, 75, 77, and 78 are amended to replace the word "having" with the word "of". Claim 75 is amended to replace the term "containing" with the term "consisting of", and claim 76 has been amended to clarify its scope. Support for the claim amendments can be found in the claims as originally filed. Therefore, the applicants believe that no new matter is added.

Claims 24, 27, 29, 34, 59, 60, 62, and 74 were withdrawn as being directed to a non-elected inventions. The applicants reserve the right to file one or more divisional applications to the subject matter of the withdrawn claims.

This response is filed within the shortened statutory period for response, no fee due. The applicants respectfully request consideration and allowance of the present application.

### **Patentability Remarks**

#### ***Rejection under 35 U.S.C. §112 –***

Claim 76 was rejected under 35 U.S.C. §112, second paragraph, for being indefinite. The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

The structure in claim 76 is amended to clarify that R<sub>6</sub> is H. Therefore, the applicants respectfully submit claim 76 is not indefinite and request withdrawal of this rejection.

*Rejections under 35 U.S.C. §102 –*

Claims 23, 61 and 75 were rejected under 35 U.S.C. §102(a) as being anticipated by Johnson (WO 97/04004). The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

Claims 23, 61, and 75 are amended to replace the term “having” with “of”. In view of these amendments, the applicants respectfully submit that claims 23, 61, and 75 are not anticipated by Johnson and request withdrawal of this rejection.

Claims 61 and 75 were rejected under 35 U.S.C. §102(b) as being anticipated by Reetz (*Angew. Chem. Int. Ed. Eng.* **31(12)**, 1626 - 1629, 1992). The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

As noted previously, claims 61 and 75 are amended to replace the term “having” with “of”. The applicants respectfully submit that claims 61 and 75 are not anticipated by Reetz and request withdrawal of this rejection.

Claims 23 and 61 were rejected under 35 U.S.C. §102(b) as being anticipated by Falender *et al.* (*Biocatal. Biotransform.* **13(2)**, 131 - 139, 1995). The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

As noted previously, claims 23 and 61 are amended to replace the term “having” with “of”. The applicants respectfully submit that claims 23 and 61 are not anticipated by Falender *et al.* and request withdrawal of this rejection.

Claims 23, 61, and 75 were rejected under 35 U.S.C. §102(b) as being anticipated by Chang (*Bioorg. Med. Chem. Lett.* **2(10)**, 1207 - 1212, 1992). The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

As noted previously, claims 23, 61, and 75 are amended to replace the term “having” with “of”. The applicants respectfully submit that claims 23, 61, and 75 are not anticipated by Chang and request withdrawal of this rejection.

Claim 75 was rejected under 35 U.S.C. §102(e) as being anticipated by Webber *et al.* (U.S. Pat. No. 6,214,799). The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

As noted previously, claim 75 is amended to replace the term “having” with “of” and to replace the term “containing” with the term “consisting of”. The applicants respectfully submit that claim 75 is not anticipated by Webber *et al.* and request withdrawal of this rejection.

Claims 75, 77, and 78 were rejected under 35 U.S.C. §102(e) as being anticipated by Eisenbach-Schwartz *et al.* (U.S. Pat. No. 6,126,939). The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

Claim 75 is amended to replace the term “containing” with “consisting of”. Further, claims 75, 77 and 78 are amended to replace the term “having” with “of”. The applicants respectfully submit that claims 75, 77, and 78 are not anticipated by Eisenbach-Schwartz *et al.* and request withdrawal of this rejection.

*Rejections under 35 U.S.C. §103 –*

Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Falender *et al.* The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

Falender *et al.* only teach the synthesis of the tetrapeptide ethylesters but do not attribute any particular use or activity to the compounds taught. In other words, this reference neither discloses nor suggests a utility for the described compounds and therefore a person of ordinary skill in the art would have no practical reason to make the reference compounds much less any structurally related compounds. See *In re Stemniski*, 170 USPQ 343 (CCPA 1971), which was reaffirmed *In re Dillon*, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990).

*In re Stemniski* involved a *prima facie* case of obviousness similar to the present application. The Court asked “[h]ow can there be obviousness of structure, or particularly of the subject matter as a whole, when no apparent purpose or result is to

be achieved, no reason or motivation to be satisfied, upon modifying the reference compounds' structure? Where the prior art reference neither discloses nor suggests a utility for certain described compounds, why should it be said that a reference makes obvious to one of ordinary skill in the art an isomer, homolog or analog of related structure, when that mythical but intensely practical, person knows of no 'practical' reason to make the reference compounds, much less any structurally related compounds? Furthermore, where "the prior art does not disclose or suggest any usefulness for the compounds it describes and the applicant does describe a usefulness conforming with statutory requirements for the closely related but novel compounds he discloses. We have concluded they do not. We think progress in the useful arts is ill served by denying patents to inventors in the circumstances at bar". *Stemniski*, 170 USPQ at 347-48.

Further the Court in *In re Dillon* made clear that an applicant may rebut the *prima facie* case by showing that it "is so deficient that there is no motivation to make what might otherwise appear to be obvious changes" and furthermore that "a presumption is not created when the reference compound is so lacking in any utility that there is no motivation to make close relatives". *Dillon*, 16 USPQ2d at 1901.

The applicants respectfully submit that one of ordinary skill in the art reading the disclosure of Falender *et al.* would have no motivation to synthesize the compounds of claim 23 since Falender *et al.* disclose no utility for such compounds. Therefore, the applicants respectfully request withdrawal of this rejection.

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Inventor(s): Andersen *et al.*  
Attorney Docket No.: 108281-00000


### III. CONCLUSION

In view of the amendments and remarks above, the applicants respectfully submit that this application is in condition for allowance and request favorable action thereon.

In the event that this response is not timely filed, the applicants hereby petition for an appropriate extension of time. The fee for this extension, along with any additional fees that are required with respect to this response, may be charged to Deposit Account No. 01-2300, referencing Attorney Docket No. 108281-00000.

Respectfully submitted,

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